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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,210

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Keneth K. Cyr

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/750,210	Applicant(s) CYR ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2009 has been entered. Applicant amended claims 1,6,8,9,11,13,15,20,22,23,27,34, and 35. Applicant's amendments to independent claims 15 and 27 rendered the previous double patent objection moot. Claims 1-38 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 USC 101. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive

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material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 1-14 fail to recite a computer program that is embodied on a computer-readable medium. The claims are merely directed to an “engine” (i.e. computer program per se).

Claims 15-38 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the

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method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 15-38 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-

[http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 recites the limitation "the set of rules". There is insufficient antecedent basis for this limitation in the claim as claim 11 upon which claim 12 depends was amended and no longer recites a set of rules.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBusk (US 5,682,728) hereafter know as DeBusk in view of DeBusk (US 2001/0016821) hereafter know as DeBusk 821.

Referring to claim 1. DeBusk discloses a system for automatically fulfilling orders for clinically related supplies, comprising:

- An interface to a supply chain engine, the supply chain engine automatically generating at least one order for clinically related supplies based upon supply consumption data derived from documentation of at least one clinical event, the supply consumption data including items used or consumed during the at least one clinical event, wherein the clinical event is carried out at a clinically related site having a plurality of clinical departments (DeBusk: column 5, lines 6-21 and column 6, lines 47-59). The examiner submits that DeBusk discloses generating orders based upon specific patient's needs in a clinical event such as surgery.
- A fulfillment engine, communicating with the interface to the supply chain engine to receive the at least one order, the fulfillment engine, upon determining the clinically related supplies are suitable for aggregation, aggregating a plurality of orders for the clinically related supplies for delivery from a vendor before

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triggering delivery of the clinically related supplies from the vendor, wherein the plurality of orders are received from more than one of the plurality of clinical departments (DeBusk: column 3, lines 25 – 50 and column 5, line 50 – column 6, line 25 disclosing distributors delivering supplies to the appropriate area (such as the OR) in order to minimize cost and maintain proper inventory).

- DeBusk discloses all of the above but does not explicitly teach generating an order based upon real time supply consumption data generated while a clinical event is carried out. DeBusk 821 discloses a system for automatically fulfilling orders for clinically related supplies including generating an order based upon real time supply consumption data generated while a clinical event is carried out (DeBusk 821: abstract, figure 10, and paragraph 120). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the system of DeBusk to have included generating orders based on real time supply consumption data, as taught by DeBusk 821, in order to allow for tracking of resource consumption during a procedure for the purpose of inventory analysis (DeBusk 821: paragraph 128).

Referring to claim 2. The combination of DeBusk and DeBusk 821 further discloses a system wherein the clinically related site comprises a hospital facility (DeBusk: column 1, lines 13-39).

Referring to claim 3. The combination of DeBusk and DeBusk 821 further discloses a system wherein the supply consumption data includes clinically available

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quantities of surgical devices (DeBusk: column 1, lines 36-48, column 2, lines 29-40, and column 6, lines 47 - 59).

Referring to claim 4. The combination of DeBusk and DeBusk 821 further discloses a system wherein the supply chain engine generates the at least one clinical supply order based upon at least one clinical quantity threshold (DeBusk: column 3, lines 25 – 50).

Referring to claim 5. The combination of DeBusk and DeBusk 821 further discloses a system wherein the at least one order for clinically related supplies comprises a purchase order (DeBusk: column 2, line 41 – column 3, line 24).

Referring to claims 6-7. The combination of DeBusk and DeBusk 821 further discloses a system wherein the supply consumption data includes supply codes captured in the clinically related site and are manually entered codes (DeBusk: column 3, lines 25-50).

Referring to claims 8-9 and 11. The combination of DeBusk and DeBusk 821 further discloses a system wherein the clinically related supplies are suitable for aggregation when the clinically related supplies are categorized as non-time sensitive, non critical, or as receiving a favorable purchase price when ordered in a batch (DeBusk: figure 3 and column 5, lines 50 – 67 and column 6, lines 1 - 25 disclosing combining supplies together and timing delivery based on a given care event and historical records relating to frequency of occurrence of a given care event in order to minimize cost in the supply chain). Additionally, the Examiner further notes the recited “when supplies are categorized as non-time sensitive, non critical, or as receiving a

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favorable purchase price” does not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted “when” step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Referring to claim 10. The combination of DeBusk and DeBusk 821 further discloses a system wherein the at least one order for clinically related supplies is associated with an individual patient supply record (DeBusk: column 6, lines 47-59).

Referring to claim 12. The combination of DeBusk and DeBusk 821 further discloses a system wherein (a) the set of rules comprising a set of selectors based upon patient condition information (DeBusk: column 4, lines 30-65).

Referring to claims 13-14. The combination of DeBusk and DeBusk 821 further discloses a system wherein the fulfillment engine is local or remote to the clinically related site (DeBusk: column 5, lines 6-21).

Referring to claim 15. The combination of DeBusk and DeBusk 821 disclose all of the above including generating an order based on real time supply data and triggering delivery and further discloses a method for automatically fulfilling orders for clinically related supplies, comprising:

tracking a clinical supply inventory at a clinically related site (DeBusk: abstract);

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generating a pick ticket including a selection of clinically related supplies for a clinical event (DeBusk: column 6, lines 47 - 59 disclosing a selection of supplies for a specific patient's treatment);

retrieving the clinically related supplies from storage (DeBusk: column 5, lines 22 - 50);

DeBusk discloses the above but does not explicitly disclose consuming supplies during a clinical event and updating a patient supply record in real time. DeBusk 821 discloses consuming the clinically related supplies during the clinical event and updating a patient supply record in real time to generate real time supply consumption data indicating the clinically related supplies were consumed in the clinical event (DeBusk: 821: paragraph 120). The examiner notes that the motivation to combine the references would be the same as in the rejection of claim 1.

Referring to claims 16-21. Method claims 16-21 are rejected under the same rationale set forth above in the rejection of systems claims 2-7 containing similar limitations.

Referring to claim 22. The combination of DeBusk and DeBusk 821 further discloses a method, wherein the at least one order comprises a plurality of orders, further comprising a step of aggregating the orders for clinically related supplies for delivery from a single vendor (DeBusk: figure 2 disclosing multiple manufacturers supplying a single distributor).

Referring to claim 23. The combination of DeBusk and DeBusk 821 further discloses a method wherein the orders for clinically related supplies are aggregated for

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a plurality of clinical departments within the clinically related site (DeBusk: column 3, lines 25 – 50 and column 5, line 50 – column 6, line 25 disclosing distributors delivering supplies to the appropriate area)

Referring to claims 24-38. Method claims 24-38 are rejected under the same rationale set forth above in the rejection of systems claims 1-14 and method claims 15 and 22-23 containing similar limitations.

Response to Arguments

Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason B Dunham/
7/23/09

Jason Dunham
Examiner, Art Unit 3625